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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,559	10/17/2003	Shinichi Yoshimura	244078US3	8982
22850	7590	05/27/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BASTIANELLI, JOHN	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/686,559	Applicant(s) YOSHIMURA ET AL.	
	Examiner John Bastianelli	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/15/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. The examiner acknowledges applicant's election, with traverse, of Species I, corresponding to Figs. 1-7, and claims 1-4 and 9. Regarding applicant's claim that the search and examination can be made without an undue burden on the examiner, the examiner disagrees as extra searching and examination would be needed therefore placing an undue burden on the examiner. Claims 5-8 are withdrawn and claims 1-4 and 9 are examined below.

### ***Drawings***

2. The drawings are objected to because the specification and claims state that the magnetic cover 34 is cylindrical, but in the drawings (specifically, Figs. 7 and 9) it is rectangular. It is unclear as to whether the insulation film is on the inner or outer surface of the magnetic cover. It is also not understood where the film non-formed portion having no insulation film is. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: In the specification and claims, it is stated that the magnetic cover 34 is cylindrical, but in the drawings (specifically, Figs. 7 and 9) it is rectangular. It is also not understood where the film non-formed portion having no insulation film is. Appropriate correction is required.

### ***Claim Objections***

4. Claims 1 and 3 are objected to because of the following informalities: In the specification and claims, it is stated that the magnetic cover 34 is cylindrical, but in the drawings (specifically, Figs. 7 and 9) it is rectangular. Also, the applicant states that it is cylindrical in claim 1 and repeats it in claim 3. Claim 4 is not understood, as where is this contact or joint surface and what is the member constituting a magnetic circuit? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Klimowicz et al. US 4,501,299.

Klimowicz discloses a solenoid valve comprising a valve section having a valve member 11 which comes into contact and separates from a valve seat 51 to switch passage, and a solenoid portion for driving the valve member, wherein the solenoid portion comprises a fixed magnetic member 71, a bobbin 22 around which a coil 24 is wound, a magnetic cover 29 surrounding the coil and constituting an outer profile of the solenoid portion, a magnetic plate 28 provided in the magnetic cover adjacent to the bobbin, and a moving core 41 which is slidably fitted into center holes formed such as to pass through the magnetic plate and the bobbin and which is adsorbed by the fixed magnetic member, an electrical insulation film (col. 6, lines 42-48) is formed on at least an inner surface among inner and outer surfaces of the magnetic cover. Regarding claim 2, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The electrical insulation film is a resin. The magnetic cover has an occluded section 31 which comes into contact with the fixed core and the other end with an opening section. A contact surface between the magnetic cover and a member 28 has a film non-formed portion having no insulation film.

7. Claims 1-2 and 9, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Neff et al. US 5,192,936.

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Neff discloses a solenoid valve comprising a valve section having a valve member which comes into contact and separates from a valve seat (col. 2, lines 13-20, valves inherently have valve seats) to switch passage, and a solenoid portion for driving the valve member, wherein the solenoid portion comprises a fixed magnetic member 13, a bobbin 22 around which a coil 30 is wound, a magnetic cover 43 surrounding the coil and constituting an outer profile of the solenoid portion, a magnetic plate 12 or 31 provided in the magnetic cover adjacent to the bobbin, and a moving core 18 and 15 which is slidably fitted into center holes formed such as to pass through the magnetic plate and the bobbin and which is adsorbed by the fixed magnetic member, an electrical insulation film 45 is formed on at least an inner surface among inner and outer surfaces of the magnetic cover. Regarding claim 2, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113). The material is electrical insulation material and can be deposited by a vacuum. The shape of the bobbin, center holes of the magnetic plate and moving core are oval (Figs. 3-5).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kolchinsky and Frantz disclose electrical insulation in valves. Thompson and Nicholson disclose oval shapes in a valve.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Bastianelli whose telephone number is (571) 272-4921. The examiner can normally be reached on M-F (9:00-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Bastianelli  
Primary Examiner  
Art Unit 3751



JB

May 17, 2005